

REMARKS

Claims 42-131 were previously pending in this application. By this amendment, Applicant is canceling non-elected claims 42-87, 102 and 105-131 without prejudice or disclaimer. Pending claims 88-89 and 95 have been canceled. Claims 90-94, 96-97, 99-100, 103, and 104 have been amended. New claim 132 was added. As a result claims 90-94, 96-101, 103-104 and 132 are pending for examination with claim 104 being an independent claim. No new matter has been added.

Rejections Under 35 U.S.C. §112

The Examiner has maintained the rejection of claims 88-101 and 103 under 35 U.S.C. §112, first paragraph. Independent claim 104 was not rejected. Applicant has canceled claim 88 and amended the relevant claims depending from claim 88 (claims 90-94, 96-97, 99-100, and 103) to change the dependency to ultimately depend from non-rejected claim 104. Claims 98 and 101 were not amended because the original claims 98 and 101 properly depend from currently pending claims. Claim 104 was amended to clarify that the stabilization occurs on the backbone. The amendment does not alter the scope of the claim. Applicant realized that the prior wording might be unclear and amended the claim to clarify the scope. Claim 90 was amended to add the limitation that the oligonucleotide is between 8 and 30 nucleotides in length and to remove the limitation regarding phosphodiester. Since claim 104 requires stabilization, the backbone cannot be fully phosphodiester. Support for this amendment is found in the specification as filed, for instance, on page 16 lines 1-3.

Accordingly, withdrawal of this rejection is respectfully requested.

Rejections Under Non-Statutory Double Patenting

The Examiner rejected claims 88-101, 103 and 104 under the judicially created doctrine of double patenting as being unpatentable over US Patent Nos. 6,207,646; 6,194,388; and 6,239,116. Applicants submit terminal disclaimers to overcome this rejection. In view of the terminal disclaimers, all of the rejections of independent claim 104 should be withdrawn.

Accordingly, withdrawal of this rejection is respectfully requested.

Election/Restriction


The Examiner has indicated that claims 42-87, 102, and 104-130 are drawn to non-elected inventions. Applicants' records of prosecution reflect that claim 104 is part of the elected invention and that claim 131 is withdrawn. The office action (and previous office actions) provides a rejection of claim 104. It is Applicants understanding that the indication of claim 104 as a non-elected invention and the exclusion of claim 131 as a withdrawn claim are typographical errors. Claims 42-87, 102, and 105-131 have been canceled herewith.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
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